

### **DETAILED ACTION**

1. This communication is a **Final Office** action in response to the amendment filed June 3, 2011.

#### ***Status of Claims***

2. Claims 1-69, 71, 76, 78 and 82 are canceled. Claims 70, 83 and 84 are amended. Claims 72-75, 77 and 79-81 are as previously presented. Claims 85-91 are new. Claims 70, 72-75, 77, 79-81 and 83-91 are pending.

#### ***Claim Objections***

3. Claim 87 is objected to because of the following informalities: Claim 87 recites "...the formal quotation *binding upon the insurance*;" Perhaps Applicant meant "binding upon the insurance *company*." For examination purposes, that is how it was interpreted. Appropriate correction is required.

#### ***Response to Arguments***

4. Applicant's arguments filed November 24, 2010 have been fully considered but they are not persuasive.

(a) Applicant argues [pg. 7, third ¶] ... that one skilled in the art at the time of the invention would not find it obvious to modify McLeod with Fletcher and Ghosh to arrive at the method of amended claim 70. Indeed, it is only through the use of improper hindsight knowledge of the present invention that the applied references would be combined at all.

**In response** – applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The references are analogous art. McLeod and Fletcher are both directed to a specialty line of insurance (i.e. surplus lines insurance), which requires licensing for insurance agents, producers and/or brokers. Ghosh teaches system and method for managing licensing information for insurance agents/producers/brokers and agencies.

The Examiner maintains the rational for combining the references as cited in the Office Actions.

**(b)** Applicant argues [pgs. 7, last ¶] ... McLeod method does not contemplate any computer-implemented interaction between an insurance producer and a broker, much less a computer-implemented step relating to a broker licensed in a jurisdiction accepting a submission for a surplus lines insurance policy from an insurance producer that is not licensed in the jurisdiction as recited in amended claim 70.

**(c)** Applicant argues [ pg. 8, first ¶ ] In the case where a broker does not have the proper surplus lines license, the McLeod method prohibits the access of the unlicensed broker to the surplus lines insurers through the website. McLeod, p. 2 ("Agents will need to hold surplus lines licenses to access surplus lines insurers through [the website].").

Instead, in McLeod, "An agent without such a license can have his or her submissions referred through surplus lines-licensed intermediaries registered with the site." Id. McLeod is silent as to what steps are performed in order to establish that relationship.

**In response to (b) and (c)** – McLeod recites the following (see highlighted section on page 2):

Agents will need to hold surplus lines licenses to access surplus lines insurers through iwix.net. An agent without such a license can have his or her submissions referred through surplus lines-licensed intermediaries registered with the site.

There is no mention of a broker/agent requirement of having a "proper surplus lines license". The requirement is simply that a broker/agent possesses a surplus line license (as interpreted, being licensed to broker surplus line transactions in at least one state). As Fletcher discloses, a surplus lines licenses are issued on a state-by-state basis. Therefore, a broker/agent possessing a surplus lines license for a first state (i.e. licensed) can have access to iwix.net; even though the same broker/agent is unlicensed in the remaining states. For example, a broker/agent possessing only a surplus lines license for the state of Florida, can access iwix.net and submit specialty risks for the state of Georgia (where the broker/agent is unlicensed).

In addition, Fletcher discloses that it is common among surplus line brokers to conduct business which involves the selling multistate insurance coverage. In conducting this type of business, the surplus lines broker faces a tax issue (i.e. paying premiums

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taxes). Fletcher further discloses that in the admitted market, premium taxes are paid by the licensed companies, directly to the state, on the amount of premium the company writes in that state. In the surplus lines market, premium tax payments are the unique and the sole responsibility of the broker who allocates and remits them to the state authorities. However, in some cases, a nonresident surplus lines broker cannot pay taxes to the states where portions of the multistate surplus lines risk lie, because the broker does not have, and cannot obtain, a non-resident surplus lines license (key points of the article on highlighted on pages 1 and 2).

(d) Applicant argues [pg. 8, third ¶] ... Accordingly, McLeod fails to teach or suggest a computer-implemented method including steps of: identifying, by the server ..., at least one broker [so] licensed in the jurisdiction ...; notifying at least one identified broker about the submission; permitting at least one identified broker access, through the server, to the submission; [and] receiving, at the server, an acceptance of the submission for the insurance policy from one identified broker.

**In response to (d) – see McLeod Page 2, except the “identifying” step (see Ghosh (¶0013-0014, ¶0026 ¶0030, ¶0040-0041, ¶0047-0048, ¶0057 and Figs 3-4).**

(e) Applicant argues [pg. 8, second ¶] ... Indeed, the McLeod method teaches away from the method of amended claim 70 by emphasizing that the unlicensed broker is not allowed access through its website to the surplus lines insurers. Under such circumstances, the McLeod method requires the unlicensed broker to refer the request to a

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broker that is properly licensed and to have the licensed broker interact with the website to obtain a quotation.

**In response to (e)** – Teaching away requires discouragement, and McLeod on pg. 2 merely discloses that "Agents will need to hold surplus lines licenses to access surplus lines insurers through iwix.net." See *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) ("[a] reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant"). Just because McLeod requires agents to hold a surplus lines license, does not mean the lack of a surplus lines license is discouraged.

**(f)** Applicant argues [pg. 8, last ¶ ] ... Furthermore, McLeod fails to teach or suggest a computer-implemented method that includes the steps of determining, by the server, whether the submission satisfies a set of guidelines; and if the submission satisfies the set of guidelines, generating a quotation, by server, for the insurance policy in the submission from an insurance company.

**In response to (f)** – see Freedman et al., Pub. No. 2002/0002475

The Examiner maintains that the combination of McLeod, Fletcher, Ghosh and Freedman teach all of the limitations as recited in claim 70.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 70, 77, 80 and 86** are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas McLeod, "Web site connects insurers, agents", (hereinafter "McLeod"), in view of Meg Fletcher, "Opportunities expanding for surplus lines insurers" (hereinafter "Fletcher"), Ghosh et al., Pub. No. 2001/0032094 (hereinafter "Ghosh") and Freedman et al., Pub. No. 2002/0002475 (hereinafter "Freedman").

**Note:** The claim language in the following limitation of **Claim 70** is a bit confusing:

- if the submission satisfies the set of guidelines, generating a quotation, by the server, *for the surplus lines insurance policy in the submission from an insurance company.*

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The Examiner's interpretation of the limitation, based on ¶0101 and Fig.3 of Applicant's disclosure:

1- the surplus lines insurance policy is **\*\*not\*\*** in the submission (submission = applicant insurance data; from 1<sup>st</sup> limitation)

2- the submission is **\*\*not\*\*** from an insurance company

For examination purposes, the limitation has been interpreted as:

- if the submission satisfies the set of guidelines, generating a quotation, by the server

**As to claim 70**, McLeod discloses a computer-implemented method comprising:

- accepting, at a server, a submission of applicant insurance data for placement of a surplus lines (e.g. specialty risks) insurance policy transmitted by an insurance producer operating in a jurisdiction (pg.2; which discusses that agents can access the Internet Wholesale Insurance Exchanger (iwix.net) and submit specialty risks for quotations by participating insurers);
- notifying at least one identified broker about the submission (pg.2; which discusses the system e-mailing an insurer with a link to the site for viewing the (specialty risk) submission);
- permitting at least one identified broker access, through the server, to the submission (pg.2; which discusses insurers registering on the iwix.net site; and the system e-mailing an insurer with a link to the site for viewing the (specialty risk) submission);

- receiving, at the server, an acceptance of the submission for the surplus lines insurance policy from one identified broker (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent; Interpretation: delivery of quotes to the agent implicitly teaches the acceptance of the submission by an insurer);
- determining, by the server, whether the submission satisfies a set of guidelines (pg.2; which discusses Insurers registering on the site will *set guidelines* for the types of business they're willing to consider, allowing iwix.net to point agents only to those underwriters able to provide quotations);
- sending, by the server, the quotation to the insurance producer (pg.2; which discusses the system will e-mail the insurers a link to the site for viewing the submission and the system will deliver quotes to the agent).

McLeod teaches that agents will need to hold surplus lines licenses to access surplus lines insurers through iwix.net. (pg.2). However, McLeod does not explicitly teach the following element:

- [an insurance producer...] not being licensed in the jurisdiction to broker insurance policies of the type specified by the submission.

However, Fletcher discloses that it is common among surplus line brokers to conduct business which involves the selling multistate insurance coverage. In conducting this type of business, the surplus lines broker faces a tax issue (i.e. paying premiums taxes). Fletcher further discloses that in the admitted market, premium taxes are paid by the licensed companies, directly to the state, on the amount of premium the company writes in that state. In the surplus lines market, premium tax payments are the unique and



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the sole responsibility of the broker who allocates and remits them to the state authorities. However, in some cases, a nonresident surplus lines broker cannot pay taxes to the states where portions of the multistate surplus lines risk lie, because the broker does not have, and cannot obtain, a non-resident surplus lines license (key points of the article on highlighted on pages 1 and 2).

Both McLeod and Fletcher disclose elements directed to doing business in the surplus lines market. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the Internet Wholesale Insurance Exchange's (iwix.net) as disclosed of McLeod, the technique where surplus lines brokers can broker multistate risk that can include a state where the brokers are not licensed as disclosed by Fletcher, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143, Rational (A).

McLeod discloses that insurers registering on the site (i.e. iwix.net) will set guidelines for the types of business they're willing to consider, which allows iwix.net to point agents only to those underwriters able to provide quotations. *McLeod also teaches identifying insurers willing to write a particular risk* and agents will need to hold surplus lines licenses to access surplus lines insurers through iwix.net. (pg.2). However, McLeod does not explicitly teach the following limitation:

- identifying, by the server using a database containing information sufficient to identify brokers, the jurisdictions in which the brokers are licensed to place surplus lines insurance policies, and the type of surplus lines insurance

policies the brokers place, at least one broker licensed in the jurisdiction that accepts submissions of the type transmitted by the insurance producer searching broker data in the database;

Ghosh teaches a system and method for managing licensing information in which a centralized database tracks all relevant information related to licensing of agents and agencies. The licensing information includes the states in which the agent is licensed and appointment information of the agent (e.g. insurance carriers, products authorized for sale by the carrier through the agent, etc.). Ghosh teaches that the licensing information system (LIS) can be accessed by compliance officers, insurance agents, agencies, carriers and *entities requiring insurance licensing and compliance services*. For instance, external systems may include sales systems which perform queries on the LIS to *verify whether certain agents may sell particular products in a given state* (§0013-0014, §0026 §0030, §0040-0041, §0047-0048, §0057 and Figs 3-4).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Ghosh within McLeod for the motivation to provide a centralized, updated and current, database that tracks all relevant information related to licensing of agents and agencies (§0013).

McLeod discloses that Insurers registering on the site will *set guidelines* for the types of business they're willing to consider, allowing iwix.net to point agents only to those underwriters able to provide quotations. However, McLeod does not explicitly teach the following limitations:

- if the submission satisfies the set of guidelines, generating a quotation, by the server, for the surplus lines insurance policy in the submission from an insurance company.

Freedman discloses an automated insurance system which is comprised of an insurance company (e.g. the Company) and an associated financial management system. Freedman also discloses that when writing insurance policies, Agents/Brokers and/or prospective policyholders preferably complete online forms designed *to collect all of the data necessary to process insurance applications. The financial management system can then automatically calculate non-binding quotes*, which can be made available instantaneously to Agents/Brokers and prospective policyholders through the web portal. Concurrently, the financial management system will preferably organize the data from the online forms into digital applicant files, and alert the Company's underwriting division that there are active applicant files requiring attention (Abstract, ¶0110-0111 and ¶0153).

Interpretation: the process of collecting the necessary data in order to automatically calculate non-binding, implicitly teaches satisfying guidelines.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Freedman within McLeod for the motivation to provide agents, brokers, etc. with a quick estimate of insurance costs.

**As to claim 77**, McLeod teaches the following limitation:

- wherein the surplus lines insurance policy includes a property and casualty insurance policy (pg.2; which discusses iwix.net, a virtual marketplace, that will let small and medium-sized agents place specialty property/casualty coverages with surplus lines insurers).

**As to claim 80**, McLeod teaches the following limitation:

- receiving by the server an acceptance of the quotation for the surplus lines insurance policy from the insurance producer (pg.2; which discusses an agent sending a request to bind coverage through iwix.net).

**As to claim 86**, McLeod does not disclose the following limitation; however, Freedman discloses the limitation:

- wherein the quotation generated by the server is non-binding on the insurance company (¶0111).

**8. Claims 72-75** are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, Fletcher, Ghosh and Freedman as applied to claim 70 above, and further in view of Debber, Pub. No. 2003/0144887 (hereinafter “Debber”).

**As to claims 72-75**, neither McLeod, Fletcher, Ghosh nor Freedman explicitly discloses the following limitations; however, Debber teaches the limitations:

- providing a graphical user interface to the insurance producer to allow the insurance producer to enter the applicant insurance data (Abstract, ¶0010, ¶0036-0039, ¶0052, ¶0066, ¶0092 and ¶0100-0106);
- wherein the graphical user interface allows the insurance producer to enter information related to an insured entity of the surplus lines insurance policy (Abstract, ¶0010, ¶0036-0039, ¶0052, ¶0066, ¶0092 and ¶0100-0106);
- wherein the graphical user interface is provided to the insurance producer over the internet (Abstract, ¶0010, ¶0036-0039, ¶0052, ¶0066, ¶0092 and ¶0100-0106); and

- wherein the graphical user interface is configured to be displayed by an internet browser (Abstract, ¶0010, ¶0036-0039, ¶0052, ¶0066, ¶0092 and ¶0100-0106).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Debber within the McLeod, Fletcher, Ghosh and Freedman combination for the motivation to provide a method for electronically creating, filing and approving applications for insurance coverage (¶0010).

**9. Claim 79** is rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, Fletcher, Ghosh and Freedman as applied to claim 70 above, and further in view of Luchs et al., Pat. No. 4,831,526 (hereinafter "Luchs").

**As to claim 79**, neither McLeod, Fletcher, Ghosh nor Freedman explicitly discloses the following limitation; however, Luchs teaches the limitation:

- providing a database containing information describing legal requirements for placing surplus lines insurance policies of the type specified by the submission in the jurisdiction (Abstract, col.14, lines 35-45 and col. 21, lines 39-58; which discusses a central processor with a data bank containing the laws and regulations of various state agencies having governmental control over insurance transactions, such laws and regulations).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Luchs within the McLeod, Fletcher, Ghosh and Freedman combination for the motivation to provide a computerized insurance method for storing in a data bank information representing laws and regulations

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of individual state governments which control and regulate the various parameters of insurance contracts, in addition to look up tables which correlate information repeatedly called for on insurance policies (col.2, line 47 thru col. 3, line 4).

**10. Claims 81 and 87-90** are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, Fletcher, Ghosh and Freedman as applied to claims 80 and 86 above, and further in view of Jinks, Pub. No. 2002/0055862 (hereinafter “Jinks”).

**As to claims 81**, McLeod and Fletcher teach the element of the insurance policy being a “surplus lines insurance policy”; however, neither McLeod, Fletcher, Ghosh nor Freedman explicitly discloses the following limitations; Jinks teaches the limitations:

- generating the surplus lines insurance policy according to regulatory requirements of the jurisdiction related to surplus lines insurance policies of the type specified by the submission (¶0033; which discusses completing the processing of an insurance application and the issuance of an insurance policy, which includes additional information that is required by a particular state or regulatory agency).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Jinks within the McLeod, Fletcher, Ghosh and Freedman combination for the motivation to provide a method for obtaining commercial insurance quotations from a variety of insurance carriers (¶0005).

**Note:** The claim language in the following limitation of **Claim 87** is a bit confusing:

- if the submission satisfies the set of guidelines, generating a formal quotation, by the server, *for the insurance policy in the submission from the insurance company*, the formal quotation binding upon the insurance

The Examiner's interpretation of the limitation, based on ¶0102 and Fig.3 of Applicant's disclosure:

- 1- the surplus lines insurance policy is **\*\*not\*\*** in the submission (submission = applicant insurance data; from 1<sup>st</sup> limitation of claim 70)
- 2- the submission is **\*\*not\*\*** from an insurance company

For examination purposes, the limitation has been interpreted as:

- if the submission satisfies the set of guidelines, generating a formal quotation, by the server, the formal quotation binding upon the insurance company

**As to claim 87**, McLeod and Fletcher teach the element of the insurance policy being a "surplus lines insurance policy"; however, neither McLeod, Fletcher, Ghosh nor Freedman explicitly discloses the following limitations; Jinks discloses the limitations:

- receiving by the server an acceptance of the non-binding quotation for the surplus lines insurance policy from the insurance producer (¶0032; which discusses displaying quotation to agent/applicant and agent accepting quotation);
- receiving by the server additional applicant insurance data to supplement the submission (¶0033; which discusses the agent being prompted by the

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interactive insurance server *to input* additional information necessary to complete the insurance policy);

- determining, by the server, whether the supplemented submission satisfies the set of guidelines (§0033; which discusses the agent being prompted by the interactive insurance server to input additional information necessary to complete the insurance policy; the agent may be presented with a series of forms that may be filled out sequentially; and the agent may be asked to provide answers to a variety of questions regarding the nature of the applicant's business, past losses, potential hazards, and information concerning subcontractors, etc) (Interpretation: the prompting to complete a series of forms and being asked to provide answers to a variety of questions, implicitly teaches the determining limitation);
- if the submission satisfies the set of guidelines, generating a formal quotation, by the server, for the insurance policy in the submission from the insurance company, the formal quotation binding upon the insurance (§0034; which discusses the policy issuance system creating and transmitting a policy binder to the agent); and
- sending, by the server, the formal quotation to the insurance producer (§0034; which discusses the policy issuance system creating and transmitting a policy binder to the agent).

See the rejection of Claim 81 for motivation to combine.



**As to claims 88-90**, McLeod and Fletcher teach the element of the insurance policy being a “surplus lines insurance policy”; however, neither McLeod, Fletcher, Ghosh nor Freedman explicitly discloses the following limitations; Jinks discloses the limitations:

- receiving, by the server, an acceptance of the formal quotation for the surplus lines insurance policy from the insurance producer (¶0034; via the agent requesting the policy issuance system to create and transmit a policy binder to the agent implicitly teaches the limitation).
- upon receiving the acceptance of the formal quotation, generating, by the server, a binder based on the submission and the formal quotation (¶0034; which discusses the binder being displayed on the agent interface and being executed by the applicant to bind the policy and rate information for the policy, pending issuance of the actual policy).
- after generating the binder, notifying, by the server, the broker of the accepted surplus lines insurance policy that a new policy has been placed (¶0034; which discusses the binder being displayed on the agent interface and being executed by the applicant to bind the policy and rate information for the policy, pending issuance of the actual policy).

See the rejection of Claim 81 for motivation to combine.

**11. Claims 83-85** are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, Fletcher, Ghosh and Freedman as applied to claim 70 above, and further in view of Broadbent et al., Pub. No. 2001/0047326 (hereinafter "Broadbent") and Jinks.

**As to claim 83**, McLeod and Fletcher teach the element of the insurance policy being a "surplus lines insurance policy"; however, neither McLeod, Fletcher, Ghosh nor Freedman explicitly teach or disclose the following element:

- if the submission fails to satisfy the set of guidelines, notifying, by the server, an underwriter *who underwrites the surplus lines insurance policy for the broker who accepted the submission* that the submission does not satisfy the set of guidelines.

**Note:** Broadbent discloses the non-italicized element and *Jinks disclosed the italicized element*.

Broadbent discloses an automated compliance engine which is a system and method for automatically generating a set of required tasks for use in managing a mortgage loan process, including tasks required by applicably federal or state law. Broadbent also discloses a compliance workflow system that generates compliance documents and submits them to a premium broker account executive for to complete his/her respective tasks to complete the loan process. Once completed, the premium broker account executive electronically submits a task completion message to the system which compares the submissions against authorization criteria. Broadbent further discloses that if the system determines that the required criteria have not been met, the system will notify an underwriter (¶0274-0276, ¶0114 and Fig.6).

Broadbent is nonanalogous art when compared to the art of McLeod, Fletcher and Freedman; however, it has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned with, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the particular problem/issue is maintaining document compliance with legal requirements of town/state/federal agencies and regulatory boards.

McLeod, Fletcher and Freedman disclose methods for processing submissions in which a broker and underwriter are required. The submissions involve the exchange of risk.

Broadbent also discloses methods for processing submissions in which a broker and underwriter are required. The submissions also involve the exchange of risk. The difference between Broadbent and the other references is that the documents are for mortgages, not insurance policies.

An artisan in the insurance area would have recognized the similar class of problem (i.e. document compliance) and the known solutions of the prior art and it would have been well within the ordinary skill level to implement a known solution in a different environment, and the results within the different environment would have been predictable. See MPEP 2143, Rational (F).

Neither McLeod, Fletcher, Ghosh, Freedman nor Broadbent teach or discloses the element:

- an underwriter who underwrites the surplus lines insurance policy for the broker who accepted the submission

However, Jinks discloses that brokers and managing general agents (MGAs) are authorized by more than one insurance carrier to act as their agent and issue insurance premium quotations (policy quotes) and insurance policies on behalf of the carriers.

Brokers and MGAs employ underwriters to evaluate insurance risks. The underwriters in this situation must normally look to the underwriting rules established by each carrier to determine whether the carrier will insure a particular risk and the premium the carrier assigns to that risk (¶0003).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include aforementioned element as disclosed by Jinks, within the McLeod, Fletcher, Ghosh, Freedman and Broadbent combination, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143, Rational (A).

**As to claims 84**, McLeod and Fletcher teach the element of the insurance policy being a "surplus lines insurance policy"; however, neither McLeod, Fletcher, Ghosh, Freedman nor Broadbent explicitly discloses the following limitations; Jinks teaches the limitations:

- providing a graphical user interface to the underwriter to allow the underwriter to rate the surplus lines insurance policy when the insurance policy does not satisfy the set of guidelines
- providing an underwriter graphical user interface to the underwriter to allow the underwriter to review the submission (¶0015 and ¶0040; which discusses

underwriters utilizing systems tools to either evaluate risk or route the risk to a carrier for ultimate approval or denial; and underwriters accessing the system to provide manual input into the risk evaluation process for risks that cannot be evaluated automatically by the interactive insurance server).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Jinks within the combination of McLeod, Fletcher and Ghosh for the motivation to provide a method for obtaining commercial insurance quotations from a variety of insurance carriers (§0005).

**As to claims 85**, McLeod does not explicitly disclose the following limitation; however, Freedman discloses the limitation:

- wherein the underwriter graphical user interface is adapted to allow the underwriter to request more information to supplement the submission (§0113 and §0183).

**12. Claim 91** is rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod, Fletcher, Ghosh, Freedman and Jinks as applied to claim 90 above, and further in view of Reader et al., Pub. No. 2002/0143583 (hereinafter "Reader").

**As to claim 91**, neither McLeod, Fletcher, Ghosh, Freedman nor Jinks discloses the following limitation; however, Reader teaches the limitation:

- after generating the binder, notifying, by the server, an underwriter of the accepted surplus lines insurance policy that a new policy has been placed (§0059; which discusses the generation of a formal insurance contract

document defining the policy contract; and the generation of an electronic message to an underwriter regarding the contract renewal).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as taught by Reader within the combination of McLeod, Fletcher, Ghosh, Freedman and Jinks for the motivation to provide to provide a method for optimizing the application of underwriting effort involved in reinsurance and insurance contracting in order to maximize sales of services and products and minimize costs (§0006).

### ***Conclusion***

**13.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GREGORY JOHNSON/  
Primary Examiner, Art Unit 3691